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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) Q137-US5
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____	Application Number 10/666,873	Filed September 17, 2003
Signature _____	First Named Inventor Hisashi Tsukamoto et al.	
Typed or printed name _____	Art Unit 1745	Examiner Dah Wei D. Yuan

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request if being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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07/02/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 37 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



PATENT
Docket No. Q137-US5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hisashi Tsukamoto et al.

Serial No: 10/666,873

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY
CONSTRUCTION AND METHOD OF
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This communication is in response to the Office Action mailed on March 12, 2007 (the Office Action). Pending claims 39-41 and 71-80 are rejected for statutory double patenting over the claims of co-pending U.S. Patent Application serial number 10/666,860 (the cited Application). The Applicant submits that a clear legal error has been committed in rejecting claims 39-41 and 71-80 for statutory double patenting.

REMARKS

The Pending Claims

Claim 39 is the only independent claim pending in the current application. Claim 39 is directed to a method of constructing an electrode assembly. The method includes positioning a mandrel on a pin such that a portion of a first electrode strip is positioned between the mandrel and the pin. The method also includes winding the first electrode strip together with a second electrode strip so as to form a spiral roll, the spiral roll being formed after positioning the mandrel on the pin.

Rejection of Claims Under 35 USC §101

Pending claims 39-41 and 71-80 are rejected for statutory double patenting over the claims of co-pending U.S. Patent Application serial number 10/666,860 (the cited Application). This rejection is for statutory double patenting as opposed to nonstatutory double patenting. Accordingly, this rejection requires that the claims are to the same invention.

Applicant has not been offered the opportunity to elect

This rejection is double patenting in view of a pending patent application rather than in view of an issued patent. The statutory double patenting rejection is the only rejection left in both application. The third paragraph of MPEP 804(I)(B)(2) applies to exactly this situation and provides the following:

If a "provisional" statutory double patenting rejection is the only rejection remaining in both applications, the examiner should withdraw that rejection in the application with the earlier filing date and permit that application to issue as a patent. If both applications were filed on the same day, the applicant should be given an opportunity to elect which of the two should be allowed.

Since the immediate application and the cited application were filed on September 17, 2003, the "the applicant should be given an opportunity to elect which of the two should be allowed." The Applicant has not been offered this opportunity in either the immediate application or in the cited application. For this reason alone, the statutory double patenting rejection should be withdrawn and the Applicant should be given the opportunity to elect which Application should be allowed.

The claims in the immediate application and in the cited application are directed to different inventions.

A statutory double patenting rejection is not supported unless the claims in the conflicting patent applications are directed to the same invention (MPEP §804.02). However, the claims in the cited application have a different scope from the pending claims.

The Office Action appears to indicate that claim 81 of the cited application conflicts with claim 79 of the current Application. However, claim 81 of the cited application depends

from claim 20 which recites “at least a portion of the pin within the spiral roll.” This limitation is not included in claim 79 of the current application. Further, the prosecution history shows that this language makes claim 81 in the cited application patentably distinct from claim 79 in the current application. For instance, this Application and the cited application are each a Divisional of U.S. Patent Applications serial number 10/167,688 (now U.S. Patent number 6,670,071, the parent case). The Office Action mailed on June 3, 2003 in the parent case states the following:

This application contains claims directed to the following **patentably distinct** species of the claimed invention.

III-1, Claims 20-28, drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll **having at least a portion of the pin within the spiral roll.**

III-2, Claims 39-42 drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll. (Emphasis added)

The only difference in the descriptions for these “**patentably distinct** species” is the language “having at least a portion of the pin within the spiral roll.” As a result, the June 3, 2003 argues that the addition of the limitation “having at least a portion of the pin within the spiral roll” to claim 20 makes claim 20 patentably distinct from claim 39. Since this language makes claims 20 and 39 patentably distinct in the parent application, this language also makes claim 81 in the cited application patentably distinct from claim 79 in the current application. Since the claims are patentably distinct, these claims are not directed to the same invention and the double patenting rejection should be withdrawn.

Conclusion

The Applicant respectfully submits that legal error has been made by rejecting the pending claims for statutory double-patenting. For these reasons, allowance of claims 39-41 and 71-80 is respectfully requested.

Respectfully submitted



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